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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,301	12/12/2001	Matthias Stefan Bierbrauer	DE920000115US1	5600

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EXAMINER

PARTHASARATHY, PRAMILA

ART UNIT	PAPER NUMBER
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2136

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding..

Office Action Summary	Application No. 10/015,301	Applicant(s) BIERBRAUER ET AL.	
	Examiner Pramila Parthasarathy	Art Unit 2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the communication filed on May 27, 2005. No new Claims have been added. Claims 1 – 7 are pending.

Response to Remarks/Arguments

2. Applicant's remarks/arguments filed on May 27, 2005, with respect to Claims 1 – 7, have been fully considered but they are not persuasive.

Referring to the previous Office action, Examiner had cited relevant portions of the references as a means to illustrate the system as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims.

3. Ferguson et al. (U.S. Patent Number 6,810,404), teaches an electronic document management application program, wherein the program provides an efficient way to automatically import, index, categorize, store, search, retrieve, manipulate and archive electronic documents. Furthermore, Ferguson teaches that the method/program (code) involves defining an archiving precondition, analyzing a document attribute of an

electronic document and archiving the electronic document if the document attribute matches the archiving precondition.

4. Regarding independent Claims 1, 7 and independent amended Claim 6, Applicant argues that Ferguson does not teach “providing customized code”, “invoking the customized code when the off-loading request is issued” and “when the post-archiving agent is finished, marking the archived document as ‘archived’”. These arguments are not persuasive.

Ferguson teaches, “providing customized code” (Column 3 lines 47 – 59 and Column 17 lines 12 – 20 and 59 – 67), “invoking the customized code when the off-loading request is issued” (Column 3 line 60 – Column 4 line 35), and “when the post-archiving agent is finished, marking the archived document as ‘archived’” (Column 17 lines 30 – 37).

Applicant does not explicitly define or disclose “customized code” or “off-loading”. Instant application discloses, “... and invokes the pre-archiving agent on it. In Step 204, the code in this agent...”, (See Instant application Description of the preferred embodiment Page 4 lines 20 – 25) and “...invokes the post-archiving agent. The code in this agent ...”, (See Instant application Description of the preferred embodiment Page 5 lines 1 – 3).

Examiner has broadly interpreted “customized code” as a program code for accomplishing a task and “off-loading” as “to assume part of the processing demand from another device”, see Microsoft Computer Dictionary Fifth Edition, and “relieving the

intensive amount of data processing associated with a specific application from the CPU by performing these calculations in a dedicated or specialized server”, web-definition. Ferguson further discloses multiple utilities (programming codes) that perform automatically archiving, categorizing and other document manipulations that are implemented or can be implemented in software (code) using standard programming methods which are well known in the art (See Ferguson Column 3 lines 24 – 55). Off-loading applications from a server CPU to external computing device or off-loading applications to other background applications that execute in the background to support document management is not new and well known in the art in the field of network, database and service providing applications.

Examiner’s Note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

5. Applicant clearly has failed to explicitly identify specific claim limitations, which would define a patentable distinction over prior arts. Therefore, the examiner

respectfully asserts that cited prior art does teach or suggest the subject matter broadly recited in independent Claims 1, 6 and 7. Dependent claims 2 – 5 are also rejected at least by virtue of their dependency on independent claims and by other reason set forth in this office action.

Accordingly, the rejection for the pending Claims 1 – 7 is respectfully maintained.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1- 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Ferguson et al. (U.S. Patent Number 6,810,404).
7. Regarding Claim 1, Ferguson teaches and describes a method for processing documents being off-loaded in a document processing system in which requests are executed by an off-loading process (Fig. 1B, Summary; Column 3 line 24 – Column 4

line 35 and Column 17 line 12 – Column 18 line 35), said method comprising the steps of:

providing customized code for execution during the off-loading process (Column 3 lines 47 – 59, Column 17 lines 12 – 20 and 59 – 67); and

invoking the customized code when an off-loading request is issued relative to a document in the document processing system synchronously to the off-loading process (Column 3 line 60 – Column 4 line 35).

8. Regarding Claim 6, Ferguson teaches and describes a method for executing an agent comprising customized code relative to documents being archived from a document processing system (Fig. 1B, Summary; Column 3 line 24 – Column 4 line 35 and Column 17 line 12 – Column 18 line 35), said method comprising the steps of :

selecting a document resident in the document processing system for archiving (Column 14 lines 58 – 65 and Column 17 lines 21 – 25) ;

creating an archiving request for the selected document to an archiving engine associated with the document processing system (Column 17 lines 21 – 33);

invoking a pre-archiving agent, if any, on the selected document (Column 17 lines 33 – 37);

when the pre-archiving agent is finished archiving the selected document (Column 17 lines 33 – 37);

involving a post-archiving agent, if any, on the archived document (Column 17 lines 33 – 41 and Column 18 lines 24 – 30), Ferguson teaches that the file helper utility

continues to make an index of each archived document (acting as a post-archiving agent); and

when the post-archiving agent is finished, marking archived document as 'archived' (Column 17 lines 30 – 37), Ferguson teaches that a thumbnail representation ('marking archived') of each archived document.

9. Regarding Claim 7, Ferguson teaches and describes in a computing environment, a system for processing documents being off-loaded in a document processing system in which requests are executed by an off-loading process (Fig. 1B, Summary; Column 3 line 24 – Column 4 line 35 and Column 17 line 12 – Column 18 line 35), said system comprising:

means for providing customized code for execution during the off-loading process (Column 3 lines 47 – 59, Column 17 lines 12 – 20 and 59 – 67); and

means for invoking the customized code when an off-loading request is issued relative to a document in the document processing system synchronously to the off-loading process (Column 3 line 60 – Column 4 line 35).

10. Claim 2 is rejected as applied about in rejecting Claim 1. Furthermore, Ferguson teaches and describes in a computing environment, a system for processing documents being off-loaded in a document processing system in which requests are executed by an off-loading process (Fig. 1B, Summary; Column 3 line 24 – Column 4 line 35 and

Column 17 line 12 – Column 18 line 35), wherein the customized code is invoked synchronously to process the document before the document has been off-loaded from the document processing system (Column 17 lines 25 – 33).

11. Claim 3 is rejected as applied about in rejecting Claim 1. Furthermore, Ferguson teaches and describes in a computing environment, a system for processing documents being off-loaded in a document processing system in which requests are executed by an off-loading process (Fig. 1B, Summary; Column 3 line 24 – Column 4 line 35 and Column 17 line 12 – Column 18 line 35), wherein the customized code is invoked synchronously to process the document after the document has been off-loaded from the document processing system (Column 17 lines 25 – 45).

12. Claim 4 is rejected as applied about in rejecting Claim 1. Furthermore, Ferguson teaches and describes in a computing environment, a system for processing documents being off-loaded in a document processing system in which requests are executed by an off-loading process (Fig. 1B, Summary; Column 3 line 24 – Column 4 line 35 and Column 17 line 12 – Column 18 line 35), wherein the customized code forms an agent, the agent being invoked via a plug-in interface to the document processing system (Column 3 lines 30 – 55).

13. Claim 5 is rejected as applied about in rejecting Claim 1. Furthermore, Ferguson teaches and describes in a computing environment, a system for processing documents being off-loaded in a document processing system in which requests are executed by an off-loading process (Fig. 1B, Summary; Column 3 line 24 – Column 4 line 35 and Column 17 line 12 – Column 18 line 35), wherein the customized code runs inside a plug-in architecture (Column 3 lines 30 – 55).

Conclusion

14. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

15. Applicant is urged to consider the references. However, the references should be evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. If applicants are aware of any better prior art than those are cited, they are required to bring the prior art to the attention of the examiner.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pramila Parthasarathy whose telephone number is 571-272-3866. The examiner can normally be reached on 8:00a.m. To 5:00p.m.. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-232-3795. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pramila Parthasarathy
July 16, 2005.


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SUPERVISORY PATENT EXAMINER
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